

REMARKS

The Office Action dated January 12, 2004, has been received and reviewed.

Claims 1-35 are currently pending in the above-referenced application. Of these, only claims 1-18 have been examined, claims 19-35 having been withdrawn from consideration pursuant to a restriction requirement and subsequent election.

Claims 1-3, 5-11, 13-16, and 18 stand rejected.

Claims 4, 12, and 17 recite allowable subject matter, the indication of which is noted with appreciation.

Claims 4, 12, and 19-35 have been canceled without prejudice or disclaimer.

New claims 36-49 have been added.

Reconsideration of the above-referenced application is respectfully requested.

Rejections Under 35 U.S.C. § 102(b)

Claims 1-3, 5-11, 13-16, and 18 stand rejected under 35 U.S.C. § 102(b) for reciting subject matter which is purportedly anticipated by the description provided in U.S. Patent 5,637,469 to Wilding et al. (hereinafter "Wilding").

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 has been amended to include some of the limitations that previously appeared in claim 4. In particular, amended independent claim 1 is drawn to an assay system that includes, among other things, at least one detection zone carried by a surface of at least a portion of a waveguide.

Wilding neither expressly nor inherently describes an assay system that includes a detection zone carried by a surface of at least a portion of a waveguide. Accordingly, it is respectfully submitted that Wilding does not anticipate each and every element of amended

independent claim 1, as would be required to maintain the 35 U.S.C. § 102(b) rejection of independent claim 1.

Claims 2, 3, 5-11, 13-16, and 18 are each allowable, among other reasons, for depending either directly or indirectly from claim 1, which is allowable.

In view of the foregoing, withdrawal of the 35 U.S.C. § 102(b) rejections of claims 1-3, 5-11, 13-16, and 18 is respectfully requested.

Obviousness-Type Double Patenting Rejection

Claims 1, 14-16, and 18 stand rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over the subject matter recited in claims 1-5 of U.S. Patent 6,316,274.

Independent claim 1 has been amended to recite an assay system that includes, among other things, at least one detection zone carried by a surface of at least a portion of a waveguide. This subject matter constitutes a portion of the subject matter that previously appeared in claim 4, which claim was not included in this rejection. Accordingly, it is respectfully submitted that amended independent claim 1 recites subject matter which is allowable over that to which claims 1-5 of U.S. Patent 6,316,274 are drawn.

Therefore, withdrawal of the obviousness-type double patenting rejection of amended independent claim 1, as well as of claims 14-16 and 18 that depend therefrom, is respectfully requested.

Allowable Subject Matter/New Claims 36-49

The indication that claims 4, 12, and 17 recite allowable subject matter is gratefully acknowledged.

As indicated previously herein, some of the subject matter that was previously recited in claim 4 has been incorporated into independent claim 1. More specifically, amended independent claim 1 now recites that the at least one detection zone of the assay system recited therein is carried by a surface of a waveguide.

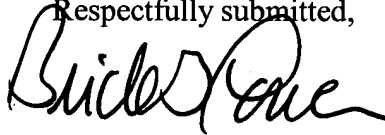
Claim 12, which has been canceled without prejudice or disclaimer, also included a recitation that the at least one detection zone be carried upon a surface of a planar waveguide.

Some of the elements that appeared in claim 17 now appear in new independent claim 36, from which claims 37-49 depend. Claims 37-49 recite substantially the same subject matter as claims 2-13 and 18, respectively.

CONCLUSION

It is respectfully submitted that each of claims 1-3, 5-11, 13-18, and 36-49 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



Brick G. Power
Registration No. 38,581
Attorney for Applicants
TRASKBRITT, PC
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: April 12, 2004

BGP/dp
Document in ProLaw